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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/530,513	08/22/2005	Ralf Dunkel	CS8479/LeA 36187	9581
34469	7590	11/16/2007		
BAYER CROPSCIENCE LP Patent Department 2 T.W. ALEXANDER DRIVE RESEARCH TRIANGLE PARK, NC 27709			EXAMINER STOCKTON, LAURA LYNNE	
			ART UNIT 1626	PAPER NUMBER
			MAIL DATE 11/16/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/530,513

Applicant(s)

DUNKEL ET AL.

Examiner

Laura L. Stockton, Ph.D.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on August 28, 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 18-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 18-25, 27 and 29-33 is/are rejected.
- 7) ☒ Claim(s) 26 and 28 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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**DETAILED ACTION**

**Claims 18-33 are pending in the application.**

***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on August 28, 2007 has been entered.

***Response to Amendment***

The Declaration under 37 CFR 1.132 filed February 23, 2007 is insufficient to overcome the rejection of claims 18-25, 27 and 29-33 based upon

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obviousness-type double patenting and 35 USC 103 as set forth in the last Office action because the showing is not commensurate in scope with the instant claims. In re Greenfield, 197 U.S.P.Q. 227 (1978) and In re Lindner, 173 U.S.P.Q. 356 (1972). Also see M.P.E.P. 716.02(d). For instance, instant Example 2, found on page 39 of the instant specification, Examples 6 and 7 on page 41 of the instant specification, etc. should also have been compared in the comparison study as well as the specific prior art examples cited in the 35 USC 103 rejection.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct

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from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 18-25, 29 and 31-33 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 22-33 and 35-37 of copending Application No. 10/502,994. Although the conflicting claims are not identical, they are not patentably distinct from each other because the difference between the compounds of the copending

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application and the compounds instantly claimed is that of a hydrogen versus a methyl group on the nitrogen of the carboxanilide group (secondary amines in the copending application versus the instant claimed tertiary amines). Compare Example 6 on page 41 of the instant application and Example 2 on page 32 of copending Application No. 10/502,994.

It is sufficient if a reference compound is so closely related to claimed compound that a chemist would find the difference an obvious variation; thus, claims are refused where the difference is primarily the one which exists between a secondary and a tertiary amine. Ex parte Bluestone, 135 USPQ 199 (1961).

One skilled in the art would thus be motivated to prepare tertiary amine products of the copending application to arrive at the instant claimed products with the expectation of obtaining additional beneficial products which would be useful for controlling undesired microorganisms.

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This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

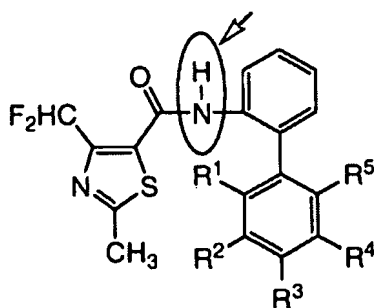
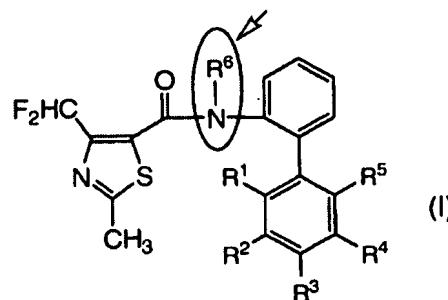
### ***Response to Arguments***

Applicant's arguments filed August 28, 2007 have been fully considered but they are not persuasive. Applicant argues that the Declaration filed February 23, 2007 under 37 C.F.R. 1.132 by Dr. Ulrike Wachendorff-Neumann shows that a representative compound of their invention in which the bridging amide nitrogen atom is N-substituted exhibits unexpectedly enhanced activity when compared to a corresponding unsubstituted compound within the copending application.

Applicant's arguments have been considered but have not been found persuasive. The difference between the compounds of the copending application and the compounds instantly claimed is that of a hydrogen

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versus a methyl group on the nitrogen of the carboxanilide group (secondary amines in the copending application versus the instant claimed tertiary amines). See below structural representations of the formula in the copending application and the instant claimed formula.

**10/502,994****Instant application**

As stated above, it is sufficient if a reference compound is so closely related to claimed compound that a chemist would find the difference an obvious variation; thus, claims are refused where the difference is primarily the one which exists between a secondary and a tertiary amine. Ex parte Bluestone, 135 USPQ 199 (1961). The Declaration filed February 23, 2007 under 37 C.F.R. 1.132 by Dr. Ulrike



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Wachendorff-Neumann was found insufficient for reasons stated above. The rejection is deemed proper and therefore, maintained.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 18-25, 27 and 29-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walter et al. {WO 02/059086} and Elbe et al. {CA 2,474,902}, each taken alone or in combination with each other and each in further combination with Kanji et al. {JP 08/176112}. A partial translation of the JP document

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was provided with a previous Office Action and will be referred to hereinafter.

Determination of the scope and content of the prior art (MPEP  
§2141.01)

Applicant claims thiazole compounds. **Walter et al.** (pages 1, 2 and 8-16; and especially compound 4.19 on page 32; and compound 7.03 on page 39) and **Elbe et al.** (pages 1, 4 and 15-30; and especially Example 1 on page 31) teach thiazole compounds which are structurally similar to the instant claimed compounds.

***Ascertainment of the difference between the prior art and the claims***  
***(MPEP §2141.02)***

The difference between the compounds of Walter et al. and the compounds instantly claimed is that the instant claimed compounds are generically described in Walter et al.

The difference between the compounds of Elbe et al. and the compounds instantly claimed is that of a hydrogen versus a methyl group on the nitrogen of the

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carboxanilide group (secondary amines in Elbe et al. versus the instant claimed tertiary amines).

Further, Kanji et al. teach the interchangeability of the various substituents attached to the nitrogen of the carboxanilide group (see the definition of R1 in Kanji et al. in paragraph [0009]) in thiazole compounds that are useful as microbicidal agents.

Finding of prima facie obviousness--rational and motivation (MPEP

§2142-2413)

The indiscriminate selection of "some" among "many" is *prima facie* obvious, In re Lemin, 141 USPQ 814 (1964). The motivation to make the claimed compounds derives from the expectation that structurally similar compounds would possess similar activity (e.g., controlling undesired microorganisms).

Further, it is sufficient if a reference compound is so closely related to claimed compound that a chemist would find the difference an obvious variation; thus, claims are refused where the difference is

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primarily the one which exists between a secondary and a tertiary amine. Ex parte Bluestone, 135 USPQ 199 (1961).

One skilled in the art would thus be motivated to prepare products embraced by Walter et al. or prepare a tertiary amino of the compounds taught by Elbe et al., and especially in view of the teachings in Kanji et al., to arrive at the instant claimed products with the expectation of obtaining additional beneficial products which would be useful for controlling undesired microorganisms. Since Walter et al. and Elbe et al. teach thiazole compounds that are structurally similar to each other for controlling undesired microorganisms, the combination of the prior art would also teach the instant claimed invention. The instant claimed invention would have been suggested to one skilled in the art and therefore, the instant claimed invention would have been obvious to one skilled in the art.

***Response to Arguments***

Applicant's arguments filed August 28, 2007 have been fully considered but they are not persuasive. Applicant argues that the only overlap between the instant claimed compounds and the compounds of Walter et al. is when the nitrogen of the -C(=O)-**N**-phenyl-group is substituted with a carbonyl containing substituent. In response, the Examiner agrees with Applicant's assessment. Applicant argues that broadness of scope of the Walter et al. reference. In response, although the teachings in Walter et al. reference may be considered broad to some, Walter et al. prepare compounds that are structurally similar to the instant claimed compounds. Note the various tables in Walter et al. starting on page 22. Therefore, the instant claimed compounds would have been suggested to one skilled in the art.

Applicant argues that Elbe et al. taken alone, or in combination with Walter et al., would not lead one

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skilled in the art to the instant claimed compounds.

Applicant argues that the Declaration filed

February 23, 2007 under 37 C.F.R. 1.132 by Dr. Ulrike

Wachendorff-Neumann shows that a representative

compound of their invention in which the bridging amide

nitrogen atom is N-substituted exhibits unexpectedly

enhanced activity when compared to a corresponding

unsubstituted compound within Elbe et al.

Applicant's arguments have been considered but have not been found persuasive. The difference between the compounds of Elbe et al. and the compounds instantly claimed is that of a hydrogen versus a methyl group on the nitrogen of the carboxanilide group (secondary amines in the copending application versus the instant claimed tertiary amines). As stated above, it is sufficient if a reference compound is so closely related to claimed compound that a chemist would find the difference an obvious variation; thus, claims are refused where the difference is primarily the one which

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exists between a secondary and a tertiary amine. *Ex parte Bluestone*, 135 USPQ 199 (1961). The Declaration filed February 23, 2007 under 37 C.F.R. 1.132 by Dr. Ulrike Wachendorff-Neumann was found insufficient for reasons stated above. The rejection is deemed proper and therefore, maintained.

Applicant argues that Kanji et al. would not lead those skilled in the art to their claimed invention because Kanji et al. do not teach or suggest the difluoromethyl substituent on the 4<sup>th</sup>-position of the thiazole ring nor a nitrogen substituted with a formyl group. In response, Kanji et al. is a secondary reference and as such is not required to have all the limitations to meet the claims. In regard to Applicant's argument that Kanji et al. do not teach a nitrogen substituted with a formyl group, the definition of the instant R<sup>6</sup> variable is not limited to carbonyl containing substituents. Therefore, Applicant's arguments are not persuasive.

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***Allowable Subject Matter***

Claims 26 and 28 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laura L. Stockton whose telephone number is (571) 272-0710. The examiner can normally be reached on Monday-Friday from 6:15 am to 2:45 pm. If the examiner is out of the Office, the examiner's supervisor, Joseph McKane, can be reached on (571) 272-0699.

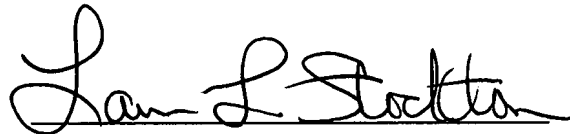
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automated information system, call 800-786-9199 (IN USA  
OR CANADA) or 571-272-1000.

The Official fax phone number for the organization  
where this application or proceeding is assigned is  
(571) 273-8300.

A handwritten signature in cursive script, reading "Laura L. Stockton". The signature is written in black ink and is positioned above the printed name and title.

Laura L. Stockton, Ph.D.

Patent Examiner

Art Unit 1626, Group 1620

Technology Center 1600

November 13, 2007